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OFFICE OF PETITIONS

In re Application of :
Yoshiki Hirano et al. : DECISION ON APPLICATION
Application No. 10/658,392 : FOR PATENT TERM ADJUSTMENT
Filed: September 10, 2003 :
Atty. Dkt. No.: 1033897-000002 :

This is a decision on the "Request for Patent Term Adjustment" filed June 23, 2006. Applicants request the reinstatement of two hundred and thirty-six (236) days of patent term, such that the initial determination of patent term adjustment under 35 U.S.C. 154(b) would be corrected from zero (0) days to two hundred and thirty-six (236) days.

The application for patent term adjustment is **GRANTED to the extent indicated herein.**

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is zero (0) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On April 24, 2006, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 0 days. On June 23, 2006, applicants timely submitted¹ an application for patent term adjustment asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance is 236 days. Applicants

¹ PALM records indicated that the Issue Fee payment was received on July 12, 2006.

assert that the patent term adjustment should not have been reduced by six hundred and three days (603) because applicants never received the Non-Final Rejection mailed by the PTO on April 21, 2004. Therefore, applicants could not file a response to the action within three months. Applicants point to the Office action returned by the postal office to the USPTO on May 4, 2004 as support for their contention. Accordingly, applicants believe the delay pursuant to 37 CFR 1.704(b) to be zero days. Applicants further assert that the USPTO failed to timely reply to the March 14, 2005 response until March 7, 2006. Applicants contend that the proper PTA determination at the time of the mailing of the Notice of Allowance is two hundred and thirty-six (236) days under CFR 1.702(a)(2).

Applicants are correct that a period of reduction of 603 days should not have been entered for applicants taking until March 16, 2006 to file a response to the Office action mailed April 21, 2004. The record establishes that the Office action mailed April 21, 2004, and properly addressed by the Office was returned by the postal service. Further, on March 7, 2006, the Office re-mailed the Office action and restarted the period for reply. Given this re-mailing and restarting of the time period, any period of reduction for applicant delay should be based on the mailing of the Office action on March 7, 2006, not April 21, 2004. As applicants filed a response to the Office action within three months, on March 16, 2006, there was no applicant delay within the meaning of § 1.704(b).

At the same time, there was no Office delay within the meaning of § 1.702(a)(1) for the Office failing to mail at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than fourteen months after the date on which the application was filed under 35 U.S.C. 111(a). The non-final Office action was mailed on April 21, 2004, which was within fourteen months of the filing date of the application, September 10, 2003. Further, the record supports a conclusion that the Office action was properly mailed to the correspondence address of record. The return of the Office action by the postal service does not appear to be due to any error on the part of the Office. As it has not been shown that this re-mailing was due to any error on the part of the Office in mailing the first Office action, the re-mailing of the Office action does not constitute a delay by the Office within the meaning of 35 U.S.C. 154(b).

Further, with respect to the reply submitted on petition to withdraw holding of abandonment, there was no Office delay

within the meaning of § 1.702(a)(2) for the Office failing to respond to a reply under 35 U.S.C. 132 or to an appeal taken under 35 U.S.C. 134 not later than four months after the date on which the reply was filed or the appeal was taken. Entry of a period of reduction of 236 days is not warranted. By decision mailed March 7, 2006, the Office responded to a petition. The provisions of § 1.702(a)(2) do not provide for entry of a period of adjustment for the Office taking in excess of four months to respond to a petition. Further, pursuant to the request to withdraw the holding of abandonment and petitioner's contention that the Office action was never received, the holding of abandonment was withdrawn, and the Office action mailed April 21, 2004 was re-mailed and the period for reply re-started. Prosecution continued with the filing of applicants' reply filed March 16, 2006. The response received on petition did not give rise to the Office mailing a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151. Thus, there was no calculation of Office delay for taking in excess of four months to respond to the response received on petition filed March 14, 2005.

Further, there was no Office delay in responding to applicants' reply filed March 16, 2006 (in response to the Office action re-mailed on March 7, 2006). The Office mailed a Notice of Allowance on April 24, 2006, which was in response to, and within four months of, the filing of the response.

However, with respect to the abandonment of the application, there is a basis for entry of a period of reduction for applicant delay. It is noted that the Office issued a Notice of Abandonment on January 11, 2005 for failure to respond to the April 21, 2004 Office action. On March 14, 2005, 2 months and 3 days later, applicants filed a Petition to Withdraw the Holding of Application and a response. Preliminarily, applicants are advised that entry of a period of reduction of 3 days is warranted pursuant to 1.704(c)(4), which provides that:

Failure to file a petition to withdraw the holding of abandonment or to revive an application within two months from the mailing date of a notice of abandonment, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date two months from the mailing date of a notice of abandonment and ending on the date a petition to withdraw the holding of abandonment or to revive the application was filed.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is zero (0) days, including 3 days of applicant delay.

Submission of the \$200 fee set forth in § 1.18(e) is acknowledged. No additional fee is required.

The Office will forward the file to the Office of Patent Publication so that the patent can be issued in a timely manner. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.



Nancy Johnson
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Office of Petitions

Enclosure: Copy of Adjustment PAIR Calculation